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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Eric O. Bodnar

Application No. 09/369,490

Confirmation No. 6852

Filed: 05 August 1999

Title: **SYSTEM AND METHODOLOGY FOR
EMBEDDING A CONTEXT-SENSITIVE
WEB PORTAL IN A COMPUTER
APPLICATION**

Group Art Unit: 2131

Examiner: Syed Zia

CUSTOMER NO. 22470

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL REPLY BRIEF

Sir:

This Appeal Reply Brief is filed in support of Appellant's appeal from the Final Office Action, filed 17 February 2006, and in response to the Examiner's Answer mailed 05 May 2006. A request for oral argument accompanies this brief.

Should it be determined that any fees are required in connection with this communication, the Commissioner is hereby authorized to charge those fees to Deposit Account No. 50-0869 (Attorney Docket No. PUMA 1024-1).

TABLE OF CONTENTS

I. AGREED POINTS	1
II. REPLY TO EXAMINER'S ARGUMENTS	1
A. Review of the Technology Disclosed and References	1
1. The Disclosed Technology	1
2. The Butler Reference	1
3. The Larson Reference.....	1
B. Rejection of Claims 89-93, 96-102, 105 and 106 under 35 U.S.C. 102(e) as being anticipated by Butler is Improper	2
1. Claims 89 and 98 (and dependent claims 91, 93, 96, 100, 102 and 105)	2
2. Claims 90 and 99, 92 and 101, and 97 and 106.....	4
C. Rejection of Claims 94, 95, 103 and 104 under 35 U.S.C. 103(a) as being unpatentable over Butler in view of Larson is Improper	5
VI. CONCLUSION	7

I. AGREED POINTS

The Examiner's Answer (hereafter "EA") acknowledges all of the preliminary sections required by the rules: Appellant's statement identifying the real party in interest, the lack of related appeals or interferences, the status of the claims, the status of amendments after final, the summary of invention and the issues on appeal. It also acknowledges the copy of appealed claims in the appendix.

In light of the agreement, the preliminary sections are not repeated in this reply.

II. REPLY TO EXAMINER'S ARGUMENTS

A. Review of the Technology Disclosed and References

While preparing this reply, we realized that this application was assigned to "Computer Security & Cryptography" Art Unit 2131. This may explain the Examiner's emphasis on "authorization" features of the references, even though the claims are not directed to authorization or cryptography.

1. The Disclosed Technology

The Examiner does not take issue with Appellant's description of the technology disclosed.

2. The Butler Reference

The Examiner's argument (EA at 9) mistakes the description of what Butler teaches for analysis of what is claimed.

We do not understand how the Examiner can disagree with the statement that "Butler's voice processing server works with ordinary telephones (*i.e.*, plain-old-telephones POTs)" that do not run browsers. The picture from Butler reproduced in our opening brief (AB at 4) shows a desk phone handset that is commonly understood not to include a browser. We quoted the abstract that explains how the voice processing system accommodates client telephone callers without computers. The Examiner does not point to any teaching in Butler that involves any client more sophisticated than a POT.



3. The Larson Reference

The Examiner does not take issue with Appellant's description of what Larson teaches.

B. Rejection of Claims 89-93, 96-102, 105 and 106 under 35 U.S.C. 102(e) as being anticipated by Butler is Improper

The Examiner's rejoinder does not quite respond to the Appellant's position.

1. Claims 89 and 98 (and dependent claims 91, 93, 96, 100, 102 and 105)

First, we asserted (AB at 6) a "telephone caller does not use an application program 201b with an embedded browser 205, both the parent and embedded browser processing parts of the same web page. ... Butler does not attribute to the telephone caller's handset (a POT) either a parent application or an embedded browser." The Examiner responds that a voice application is running on the voice processing system (EA at 10) which is a description of software running on a server, not on the caller's handset. We can readily agree that the caller's handset does not perform the claimed method.

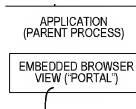
Next, we pointed out that the voice processing parent application running on the voice processing system does not have an embedded browser that displays web pages to the caller's handset. AB at 6. The Examiner's argument (EA at 10) never claims that the voice processing parent application DISPLAYS anything. The Examiner argues:

A voice application (parent application) ignores all HTML-tag information written for a graphical embedded Web browser and a graphical Web browser ignores all HTML-tag information written for the voice application. This way, the same HTML Web page is presented to both (first to a voice application then embedded browser) and processed in parts based on the recognized vocabulary of tags (i.e. regular HTML tags or special tags, such as voice application tags) as they encountered during the parsing of Web HTML page (col.2 line 43 to line 54).

Id. What the Examiner must be arguing is that some other browser running somewhere else, unrelated to the voice application, can display HTML parts of the same web page that the voice processing application interprets. The Examiner must be arguing about a browser running somewhere else, displaying HTML parts of the web page to someone other than the telephone caller, because the telephone caller does not have a display. A browser running somewhere else, unrelated to the voice processing application, is not an embedded browser.

The meaning of "embedded browser" seems to be lost in this debate. In this claim, the embedded browser operates on the web page sent from the web server to the embedded browser, after the parent application has a chance to respond to parts of

the web page that are not HTML formatting tags. The “embedded browser” is expressly claimed to be least communicating with the web server when the parent application receives the web page. In FIG. 2B, an “embedded browser” is depicted (AB at 3) that is embedded in the parent process and shares a TCP/IP internet communication with the web server(s) 260. The claim goes on to say that the “embedded browser” displays at least part of the web page. “Displaying” ordinarily means making visible to a human user.



With meanings of “embedded browser” and “displaying” in mind, the Examiner’s argument clearly does not read on the claim language. The voice processing application does not have an embedded browser for displaying pages to telephone callers and access to the same HTML web page by browsers running somewhere else does not read on the claim.

The Examiner further argues that Butler’s parent application (voice processing system 2) intercepts messages, *i.e.* special web tags on the web page. EA at 11-12. The Examiner says, “The parent application then passes to the embedded browser at least part of the intercepted web page information, not processed by the parent application, to the client device (col.6 line 3 to line 8).” First, intercepting messages is not how the claim reads. It says, “*the parent application intercepting a web page sent from the web server to the embedded browser*”. Second, as we presented in our opening brief (AB at 7), the cited passage of Butler reads:

<IMG src=“./company_logo.gif” alt=“Company
Logo”>

- 5 This first line of HTML code is not for use by the telephone user. For the computer-based user the graphical Web browser will display a graphical image of the company logo on the client computer’s display screen.

This passage indicates that a browser running somewhere else, not as part of the voice processing system, can display part of a dual-coded web page. The passage does not meet the limitation of an embedded browser receiving at least parts of a web page that intercepted by the parent application, which parent application program takes special

actions based on special key tags found in the web page. The Examiner's Answer, at 10-12, just does not respond to this reason for allowance of claim 89.

In our opening brief, we addressed allowance of claim 98 as being supported by the same positions that support allowance of claim 89, without elaboration. AB at 7-8. The Examiner is more verbose, repeating verbatim (EA at 12-14) the arguments to which we responded above.

For the several reasons given, rejection of claims 89 and 98 should be reversed. In addition, dependent claims 91, 93, 96, 100, 102 and 105 have effectively been grouped with claims 89 and 98 (AB at 11) and should be allowed for at the same reasons as the claims from which they depend.

2. Claims 90 and 99, 92 and 101, and 97 and 106

Regarding claims 90 and 99, we asserted (AB at 8) that the passage cited (Butler 5:14-37) does not teach the parent application removing audible rendering tags from the HTML page and passing the rest of the page to an embedded browser for display – Butler's voice processing system does not have an embedded browser for display. The claim language includes, "*removing the special key tags from the web page and passing the revised web page to the embedded browser for display*". The Examiner argues (EA at 15) the "removing audible rendering tags" is not defined. This shorthand for the claim language would obscure claim language that is otherwise clear and easily understood.

The Examiner's argument strains to redefine the claim language, "[t]o the extent of [sic] the claim language, 'removing audible rendering tags [sic] is defined as storing on [sic] the 'special key tags'". *Id.* First, the Examiner is treating the argument as if it were the claim language. Second, storing audible rendering tags and then interpreting them and playing them for the telephone caller does not read on the claim, when the actual words of these claims are kept in mind.

Regarding claims 92 and 101, we asserted (AB at 8) that the passage cited (Butler 6:38-45) does not teach presenting a set-up dialog to configure the parent application, responsive to a special key tag. After all, Butler's telephone callers are not running a parent application on their POT and are not authorized to configure the voice processing system's parent application. The claim language includes, "*as the special behavior of the parent application, presenting a set-up dialogue to configure the parent application*". The Examiner argues (EA at 15-16) that a caller traversing a voice

response options tree by pressing "option 1" would be configuring the voice processing system. The options tree to which the Examiner refers is one way in which a web page author can distill a page designed for display into a navigable set of options, rather than reading the whole text of the web page to the telephone caller. This is the web page author configuring the web page, not the caller configuring the voice processing system. There is no support for one of skill in the art understanding traversal of a voice response options tree to be the same as configuring a voice processing system.

Regarding claims 97 and 106, we asserted (AB at 8) that the passage (Butler 5:33-44) does not teach invoking a handler routine before passing the remainder of the web page to an embedded browser to display. The passage reads:

In step 23, the voice application for running on the voice processing system is formed "on the fly" by interpreting the HTML information (including the added tags) by an application written in the voice processing system's own language. In this way, any changes which have been made to the HTML information will be instantly reflected to the voice browser users. In this embodiment, if text-to-speech conversion is used in presenting vocal responses to the caller, the digital signal processing required to obtain the vocal responses is performed during the formation of the voice application each time a caller calls-in to the voice processing system 2.

This passage does not read on the claim elements of "*as the special behavior of the parent application, invoking a handler routine responsive to instructions in auxiliary information that is part of the special key tags*". The Examiner repeats verbatim (EA at 17) arguments made regarding claims 89 and 98, without mentioning the limitations of these dependent claims. The Examiner just did not respond

Therefore, the Examiner's rejection of dependent claims 90 and 99, 92 and 101 and 97 and 106 as unpatentable over Butler should be reversed and the claims allowed.

C. Rejection of Claims 94, 95, 103 and 104 under 35 U.S.C. 103(a) as being unpatentable over Butler in view of Larson is improper

First, we asserted (AB at 11) that not all software systems are in analogous arts. The Examiner's references, Butler and Larson are not. The Examiner's argue that "both Butler and Larson are analogous art because both of them are related to authenticating the user in a network environment to access application software." EA at 19. Neither this claim nor the Butler voice processing system's response to a caller mention

authentication. One interested in the art of authenticating a user would not pick either Butler or Larson as relevant art. Butler recognizes telephone numbers that are called, as a way of determining what web page is being accessed, but that is not what authentication means to one of skill in the art. Larson teaches a system for remote writing by an administrator of registry parameters to user workstations, but that is not what authentication means to one of skill in the art, either. The Examiner's argument does not make out a *prima facie* case that Butler and Larson are in analogous arts.

Butler and Larson are not in analogous arts because Butler teaches voice processing of web pages and Larson improves on policy implementation for configuration of application programs at logon. Any attempt to make these references analogous is purely hindsight, using the claim language as a roadmap for combining references in a way that no person of ordinary skill would do. As we explained in the opening brief (AB at 12-13), this approach is barred by cases such as *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to **the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed**"; *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify **specifically the principle, known to one of ordinary skill, that suggests the claimed combination**. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some **objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings** of the references"). The strain in the Examiner's argument for placing Butler and Larson in analogous arts reveals the hindsight that is being applied.

Second, we asserted (AB at 12) that the combination does not obviously produce the claimed results. Larson depends on a login and Butler's user does not log in. Larson depends on a user identification and Butler's users do not identify themselves. Larson implements system policies before any browser is opened by a user. Butler's

special tags are directed to delivering voice messages to users, not to triggering a behavior that includes setting values in a system registry. It is not obvious how the two references could constructively be combined much less to meet the claim limitations. We do not see any response to this position.

The Examiner may have mistaken our position for arguing that the references cannot be bodily combined. EA at 18. Rather, we asserted that the Examiner has not met the burden articulated by *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), for providing evidentiary quality support for combining references. Instead of complying with *In re Lee*, the Examiner cites *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). To the extent that *In re Keller* says anything different than *In re Lee*, the much more recent Federal Circuit case is controlling.

The Examiner's argument (EA at 19-20) does not really attempt to meet the standard of *In re Lee*. All of the discussion of authentication connections between the references is misdirected. It does not relate to the claims or motivation to combine the references in the manner claimed and runs afoul of the prohibition against using hindsight. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("**Determination of obviousness can not be based on the hindsight combination of components selectively culled** from the prior art to fit the parameters of the patented invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("**Care must be taken to avoid hindsight reconstruction by using** 'the patent in suit as a guide through the **maze of prior art references**, combining the right references in the right way so as to achieve the result of the claims in suit.' ") There is no motivation related to authentication (or security or cryptography) that would lead one of ordinary skill in the art to combine Butler and Larson in the manner claimed.

For several independent reasons, Applicant respectfully submits that rejection of claims 94-95 and 103-104 should be reversed and the claims allowed.

VI. CONCLUSION

In view of the foregoing, Appellants ask that this honorable Board reverse the rejections of the claims. In addition, it is submitted that all claims which are the subject

of this examination are now allowable, and a notice of intent to issue a patent is respectfully requested.

The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication to our Deposit Account No. 50-0869 (Attorney Docket No. PUMA 1024-1).

Respectfully submitted,

Dated: June 30, 2006

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